REMARKS

Applicants have amended claims 41 and 47-48 to correct typographical errors. Claims 40-55 are now pending in this application. No new matter has been added.

In the Office Action dated November 19, 2003, the Examiner rejected claims 40, 43-44, 46, 48-49, and 51-55 under 35 U.S.C. 103(a) as being unpatentable over Boesch et al., U.S. Patent No. 6,205,433 (Boesch) in view of Potter et al., U.S. Patent No. 5,787,402 (Potter). Examiner has also rejected claims 41-42, 45, 47, and 50 under 35 U.S.C. 103(a) over Boesch et al. in view of Potter et al. and further in view of Garber, U.S. Patent No. 5,963,923 (Garber).

In addition, the Examiner has provisionally rejected claims 40-55 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24, 26-27, and 29-39 of co-pending Application No. 09/702,956 in view of Garber. Applicants respectfully traverse the Examiner's provisional rejection of claims 40-55 55 under the judicially created doctrine of obviousness-type double patenting, however, in order to expedite the prosecution of the present invention, Applicants have included with this response a Terminal Disclaimer for co-pending Application No. 09/702,956.

Applicants have reviewed the November 19, 2003 Office Action and respectfully traverse all rejections for the reasons set forth herein. Applicants have addressed each of the Examiner's concerns for the currently pending claims and indicated why the currently pending claims are not obvious in view of Boesch, Potter or Garber, or any combination thereof and respectfully request that the Examiner meet with the Applicants to discuss such concerns in consideration of the Applicant's Request for Continued Examination of the currently pending claims.

a. Overview

Prior to discussion of the merits of the rejections, some brief comments reviewing the invention may be helpful. In general, the present invention allows a seller of goods and services to participate in an international marketplace without being an expert in currency exchange. The benefit of not bearing the normal risks associated with affiliated currency exchange can be enormous. If profit margins are thin, a change in currency pricing could overwhelm any

financial benefit a sale may bring. Sellers that are less sophisticated in currency exchange need a vehicle to be able to forecast the cost of doing business in foreign jurisdictions and price their goods and services in local currencies accordingly.

The present invention supplies such a vehicle. The present invention provides systems and methods that can guarantee a currency exchange price that will be used for any foreign transactions that involve the sale of goods or services. With the guaranteed currency exchange price, the seller can in turn guarantee a notional price for its goods and services to a foreign buyer. In order to remain manageable, the guaranteed currency exchange price is only applicable for amounts resulting from a sale of a particular seller's goods and services and limited to a predetermined time period.

Associating the currency exchange price to particular goods and services allows a currency exchange provider to better understand the magnitude and frequency of potential transactions, which can be useful in negotiating what the currency exchange price needs to be. So, for example, a currency exchange price that will be guaranteed to a seller that is an automobile manufacturer dealing in the wholesale market may differ from a currency exchange price guaranteed to a retail seller of books. The car manufacturer will most likely have relatively few, high value transactions, while the book retailer will most likely have relatively many, low value transactions. By limiting a currency exchange price to goods from a particular seller, such factors can be taken into consideration in setting the currency exchange price.

Similarly, a predetermined time period during which a currency exchange price will be adhered to can be based upon the types of goods or services offered for sale by a seller. To continue our example of the automobile manufacturer and the book retailer, the automobile manufacturer may have set times during which transactions take place, while the book retailer may experience an ongoing pattern of sales. Predetermined time periods can be set accordingly.

From a different point of view, a buyer also benefits from being able to view a price for a good or service in their local currency that will remain in effect for a given period of time. Pricing in local currency allows a buyer to readily ascertain a total cost that will be realized by

them, without a requisite knowledge of foreign exchange markets. A set time period allows a buyer to make informed decisions on when a purchase should take place.

The pending claims expressly relate to exchange of currency that results from an exchange of goods or services during a predetermined time period. Applicants respectfully submit that the new claims 40-55 address all of the Examiner's concerns as further discussed below, and request allowance of claims 40-55.

b. 35 U.S.C. §103

The Examiner has cited three U.S. patents to reject claims 40-55 under 35 U.S.C. 103(a). The Examiner rejected claims 40, 43-44, 46, 48-49, and 51-55, as unpatentable over Boesch et al. (U.S. Patent No. 6,205,433) in view of Potter et al. (U.S. Patent No. 5,787,402), and claims 41-42, 45, 47, and 50 over Boesch et al. in view of Potter et al. and further in view of Garber (U.S. Patent No. 5,963,923). Applicants respectfully traverse these rejections.

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the Examiner has not established a case for obviousness because (a) there is no motivation to modify or combine the reference teachings and (b) even if the references were combined, none of the prior art references, alone or in combination, describe or suggest all of the claimed limitations, including seven limitations specifically discussed below. In order to facilitate support for Applicant's traversal, we will first

discuss the cited art and how the claimed limitations of Applicants' invention can be distinguished over it, and then address the issue of combining references.

CLAIMED LIMITATIONS

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In the following discussion we will examine each of the cited references and indicate how the pending claim limitations are not taught or suggested by the prior art.

Boesch

In the Office Action dated July 14, 2003, Examiner cited Boesch et al. (U.S. Patent No. 5,897,621) in support of his 103(a) rejections. Examiner now cites Boesch ('433) in support of similar rejections. Boesch ('621) and Boesch ('433) both lack several limitations found in the present invention. Although Applicants previously brought these limitations to the Examiner's attention in Applicants' response to the Office Action of July 14, 2003, Applicants again discuss these limitations below for the Examiner's convenience.

In comparing the cited references to the claimed limitations, we find that Boesch is directed to a system for determining approval of a transaction between a merchant and a customer. In Boesch, the transaction is approved if an amount offered by the customer is within a "risk range" of a product price specified by the merchant. Boesch describes an embodiment where the customer makes an offer in a first currency and the product price is set by the merchant in a second currency, a computer server determines if the offer currency amount is within the "risk range" of the product price, and if it is within the risk range, the server approves the transaction (col. 2 line 63 – p. 3 lines 42).

In Boesch, the customer offer amount is calculated by a customer computer. The customer must download currency conversion rates prior to a "session" in which the customer can make an offer. The customer is to estimate an offer amount by using the customer computer

to convert one or more customer currency amounts into an amount denominated in a merchant preferred currency. If the customer waits too long, or makes a calculation mistake, the customer may end up making an unacceptable offer, in which case the customer must recalculate what may be an acceptable offer and resubmit successive offers until an offer is accepted.

The methods and systems described in Boesch actually serve as a wonderful example of what is wrong with the systems provided by the prior art. The Boesch patent describes a cumbersome and inexact process in which a customer downloads currency exchange rate data and tries to estimate an offer amount in a customer currency which will convert to an acceptable amount in a merchant preferred currency. The process described in Boesch requires a level of sophistication and processing power that may not be available to all potential customers.

The present invention enables a seller to present to a customer a sales price which is already denominated in the customer preferred currency and a predetermined length of time during which the sales price will be adhered to. Essentially, in the present invention, the sales transaction for the goods or services is conducted with the foreign exchange aspect remaining transparent to the customer.

As claimed in currently pending independent system claim 40, the present invention accomplishes the transparent foreign exchange aspect with at least five unique aspects included in the claim limitations of the pending independent claims which are not described or suggested in Boesch, or any of the other cited art.

First, the present invention indicates in a computer storage a currency exchange price which will be adhered to for amounts of currency involved in one or more transactions comprising goods and services sold by the seller. By associating the exchange rate with a particular seller, the present invention allows a currency exchange provider to take into consideration the type of goods and services sold by the seller, and market data associated with such goods and services. Accordingly, sales volume and transaction size can be taken into consideration when indicating the currency exchange rate.

Adhering to a currency exchange price brings predictability to the seller's marketplace and allows the seller to present a price for goods and services to a potential customer that is denominated in a currency local to the customer.

Second, the present invention indicates a predetermined period of time during which the currency exchange price will be adhered to. This aspect also brings predictability to the seller's marketplace and allows a buyer and seller to understand that during this predetermined time period the price of the goods or services will not change due to currency exchange rates.

Third, the present invention claims receipt of digital data into a computer storage that is descriptive of one or more executed transactions. The executed transactions need to have included a sale of goods and/or services by the particular seller. The digital data needs to include an amount of foreign currency involved in the one or more transactions as well as the date the one or more transactions were executed.

Fourth, the present invention determines that one or more of the transactions were executed during the period of time during which it was indicated the currency exchange price will be adhered to.

Fifth, the present invention calculates an amount of foreign currency which will be exchanged according to the indicated currency exchange price and the amounts of transactions executed within the predetermined time period.

Generally, independent claim 48 includes similar limitations as claim 40, but presents the limitations in the form of method steps performed by a seller implementing some embodiments of the present invention. In addition, claim 48 includes at least two additional unique claim limitations which are not described or suggested by the cited prior art. A first additional unique limitation includes calculating a price for goods and/or services offered for sale by a seller. The price is denominated in a foreign currency and is calculated using the price of the goods and/or services denominated in the base currency and the currency exchange rate tied to the seller's goods and/or services for the predetermined period of time. Another additional unique limitation includes generating an actual offer for sale for the seller's goods and/or services. The offer for

sale includes the calculated selling price denominated in a foreign currency and is limited to a time period based upon the predetermined time period during which the currency exchange price will be adhered to.

Potter

Citing Boesch in view of Potter does not diminish the unique aspects of the pending claim limitations. Potter describes a system and method for determining and offering the terms of, and subsequently carrying out (if said terms are accepted) a financial transaction, in response to input from a user. Specifically, a user enters the details of a desired financial transaction, such as an exchange of currency, into a computer connected to a system which accesses market data in order to determine and return an offer of terms for the desired transaction. If the user accepts the offer, the system causes execution of the transaction. Potter is confined to financial transactions and dictates the value of the offer.

Conversely, the present invention allows a user to sell ***goods and services at a price she desires***. The invention then facilitates sale of the offered good or service by determining an equivalent price in the currency of a foreign buyer. Although Potter provides for exchange of currency, Potter does not do so in association with a price at which a user desires to sell her goods or services. As such, Potter does not teach date of transaction execution data as part of "inputs required for transaction to commence (col. 3, lines 21-25)." While Potter discloses the display of execution date data to a user following the user's acceptance of a transaction offer and performance of the transaction, Potter does not teach the recordation of transaction execution data for the purpose of formulating currency exchange rates to be offered to users.

Thus, Potter does not help the buyers and sellers of goods and services in different currencies to address the risks associated with currency market fluctuations, and does not describe any of the unique limitations listed above that are within of the pending claims.

Garber

Similarly, citing Boesch in view of Potter and further in view of Garber also does not diminish the unique aspects of the claimed invention. As previously discussed in Applicants'

response to the Office Action of July 14, 2003, Garber is directed to methods and systems for improving currency exchange markets through the addition of a Primary Market Maker specialist. The Primary Market Maker specialist program taught by Garber is designed to replicate an over the counter bank trading environment. It merges roles traditionally filled by a combined trader and broker with a futures pit trading environment (col. 3 lines 44-50).

As such, Garber is concerned with providing liquidity by matching buyers and sellers when possible, not formulating rates for user requested transactions. Thus, Garber does not disclose "projected amount of sales." The "risk" referred to in col. 3. lines 19-37 is risk to which a market maker is exposed to as a result of fulfilling its role of providing a ready market (e.g. risk of illiquidity), as opposed to the risk of currency exchange rate fluctuation addressed in the present invention. Garber's discussion of spot price considerations at col. 2, lines 17-63 concerns Rolling Spot Currency, which involves futures, in contrast to the present invention's utilization of conventional spot prices.

The only similarity between Garber and the present invention is that they both relate to foreign exchange. Garber does not teach any of the claimed limitations included in the present invention and adds little or nothing to Boesch in terms of describing the present invention.

Applicants respectfully submit that Boesch, alone or in view of Potter and Garber, does not describe or suggest the claimed invention and therefore does not provide proper grounds for rejection. The Manual of Patent Examining Procedure (MPEP) states that a ground for rejection "must be clearly developed to such an extent that applicant may readily judge the advisability of an appeal" (MPEP § 706.07). As required by MPEP § 707.07(d), when rejecting a claim for lack of novelty, the Examiner must fully and clearly state the grounds of rejection. Further, "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." MPEP § 707.07(f).

What would be necessary to support a rejection of currently pending claim 40 under 35 U.S.C. 103(a) is one or more references that describe or suggest a computer system that incorporates the five unique aspects described above. Boesch clearly does not provide such a

description or suggestion, either alone or in combination with Potter and Garber. Furthermore, Boesch, alone or in combination with Potter and Garber, does not describe or suggest the additional limitations included in claim 48 and directed to a seller's perspective of the present invention.

If the Examiner wishes to pursue a rejection of the dependent claims, then the Examiner must additionally show a teaching of each element of each dependent claim. None of the references provided by the Examiner provide such teachings.

COMBINATION OF REFERENCES

Even if Boesch, Potter and Garber included a description of each of the claimed limitations, which they clearly do not, Applicants respectfully submit that there is no motivation for someone of ordinary skill in the art to combine the cited references. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts." In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). None of these three possible sources have been demonstrated in the Office Action dated November 19, 2003.

The only grounds offered by the Examiner for combining the cited references is "[i]t would have been obvious to one with ordinary skill in the art . . . because Garber teaches risk in currency transactions (col. 3, lines 19-37)." (Office Action of November 19, 2003, p. 4.) A blanket statement concerning "one with ordinary skill in the art" is a highly subjective and unsubstantiated statement that does not meet the Examiner's obligation to succinctly establish a prima facie case of obviousness. Also, as discussed above, Garber does not teach the type of "risk" addressed in the present invention.

In addition, Applicants respectfully suggest that the present invention is not obvious to one of ordinary skill in the arts. A person of ordinary skill in the art is presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient and often expensive, systematic research or by extraordinary insights. Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454, 227 U.S.P.Q. (BNA)

293, 298 (Fed. Cir. 1985). A person of ordinary skill in the art has even been characterized as a "routineer." Application of Laverne, 53 C.C.P.A. 1158, 356 F.2d 1003, 1006, 148 U.S.P.Q. (BNA) 674, 676 (1966). The conventional and routine methods incorporated by the industry have proven to be problematic since they do not allow a purchaser to readily ascertain a sale price the purchaser will ultimately pay for a product and/or service in the local currency, nor do they provide to a seller a vehicle with which the seller can determine a sale price for a good and/or service in a foreign currency which can be adhered to for a predetermined period of time.

In their response to the Office Action of July 14, 2003, Applicants enclosed and discussed the news article, Who collects from $800 million credit card ruling? (Washington Post, April 10, 2003), which describes a lawsuit against credit card issuers for the high fees and uncertain rates associated with multi-currency transactions involving credit card payment. This article illustrates the need for improvement upon at least one less than desirable multi-currency transaction method used by those with "ordinary skill in the arts." Accordingly, those with ordinary skill in the art have not recognized the present invention as obvious, and instead persist with less desirable methods and systems for completing multi-currency transactions.

c. Double Patenting

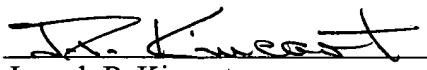
As indicated above, the Applicants respectfully traverse the Examiner's provisional rejection under the judicially created doctrine of obviousness-type double patenting over claims 24, 26-27, 29-39 of copending Application Number 09/702,956. Applicant respectfully submits that the currently pending claims are not obvious over any claims of copending Application Number 09/702,956. In addition, Applicant respectfully points out that copending Application Number 09/702,956 is a Continuation in Part Application claiming priority to the current application and therefore has an earliest possible priority date that is the same as the current application. However, in order to expedite prosecution of the present invention, Applicant has included a Terminal Disclaimer for copending Application Number 09/702,956 as the Examiner has requested.

CONCLUSION

For the reasons set forth above, allowance of this application, as amended, is courteously urged.

Respectfully submitted,

Date: February 4, 2004



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